Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

ORISON CLEVELAND III

Junior Party[1]

v.

GEORGE P. JULIANO

Senior Party[2]

Interference No. 104,186

Before URYNOWICZ, PATE and MARTIN, Administrative Patent Judges.

URYNOWICZ, Administrative Patent Judge.

JUDGMENT UNDER 37 CFR §1.658

[1]Application No. 08/241,333, filed May 11, 1994 now U.S. Patent No. 5,458,028, issued October, 17, 1995.

[2]Application No. 08/192,359, filed February 7, 1994.

Interference No. 104,186

Final Judgment

The invention at issue in this interference relates to a universal joint device for interconnecting the handle and socket portions of a socket wrench. The subject matter in issue is illustrated by count 2 as follows:

Count 2.

A universal joint device for a socket wrench, comprising:

a handle portion having a forked end member and a first spring retaining recess;

a socket portion having a forked end member and a second spring retaining recess;

an intermediate swivel block;

means for providing a first pivotal connection of the forked end member of said handle portion to said swivel block,

and means for providing a second pivotal connection of the forked end member of said socket portion to said swivel block, such that the axes of said first and second pivotal connections are at substantially right angles to each other; and

a spring concentric with and encircling said swivel block, said spring being mounted in said handle portion and said socket portion by engagement with said first and second spring retaining recesses so as to retain said spring in both tension and compression, said spring being a coil spring having a spring projection at each end thereof which extends radially inward relative to the main central portion of the spring, and with a spring projection mounted in each of said spring retaining recesses, each of said spring retaining recesses being constructed with inner and outer walls which define the inner and outer boundaries of said recesses within the respective handle portion and socket portion, said inner and outer walls being perpendicular to the longitudinal axis of said device in the unflexed position of said device.

The claims of the parties which correspond to the count are as follows:

Count 2

Cleveland III (Cleveland)	: Claims 1-7
Juliano	: Claims 10-13

This interference was declared on April 13, 1998 with count 1 corresponding exactly to Cleveland claim 1.

In a Decision on Preliminary Motions dated January 22, 1999, Juliano claims 10-12 were found unpatentable to Juliano under 35 U.S.C § 112, first paragraph, for lack of written description and a motion of Juliano to redefine the interference subject matter by adding proposed count A was treated as a motion to substitute count A for count 1, and the motion was granted. Juliano was given 21 days to file an amendment to its involved application with one or more claims corresponding to proposed count A. In response, Juliano filed claim 13, which corresponds exactly to proposed count A.

On August 2, 1999, this proceeding was redeclared by substituting count 2, Juliano's count A, for count 1 and by adding Juliano claim 13 to the proceeding as a claim corresponding to the count.

Only the party Cleveland took testimony, and both parties filed briefs. Oral argument at final hearing was conducted telephonically, with both parties participating.

Issues

In its brief at page 1, Cleveland presented the following issues:

1. Whether there is an interference-in-fact because count 2 is not supported in the specification of involved U.S. Patent No. 5,458,028 to Cleveland.

2. Whether there is an interference-in-fact because the invention claimed in Cleveland's U.S. Patent No. 5,458,028 is not obvious in view of count 2.

3. Whether Cleveland was the first to invent the subject matter of count 2 as a result of an actual reduction to practice on or about October 1990.

At page 1 of its brief, Juliano presented a statement of the issues consistent with that presented by Cleveland.

Issues 1 and 2

Rule 1.655(a) has been amended to make it clear that a Board panel at final hearing will resolve the merits of an interference (e.g., patentability or an attempt to obtain benefit of an earlier application) without giving deference to any interlocutory order which is substantive and not procedural. See Consideration of Interlocutory Rulings at Final Hearing in Interference Proceedings, 64 Fed. Reg. 12,900, 12,901 (March 16, 1999). Accordingly, we consider the substantive issues dealt with by the Administrative Patent Judge (APJ) in his interlocutory capacity and raised by the parties in their briefs giving them de novo consideration in this decision.

We consider that Cleveland's position with respect to Issues 1 and 2 is to the effect that Juliano's motion to add count 2 should not have been granted and that

Juliano's claim 13, which corresponds exactly to count 2, should not have been added to this proceeding as a corresponding claim.

In its brief, Cleveland urges that a device such as Juliano's which has a spring held and coupled to a u-joint by end projections which are bent radially inward does not suggest or disclose, and does not make obvious, its device characterized by continuing the end coils of the spring in a circumferential manner and placing them into retaining grooves. Likewise, a device which has a spring held and coupled to a u-joint by continuing the end coils of the spring in a circumferential manner and placing them into retaining grooves does not suggest or disclose, or make obvious, a spring held and coupled to a u-joint by end projections which are bent radially inward.

We are of the opinion that Juliano's motion to add count 2, which was treated by the APJ as a motion to substitute count 2 for count 1, should not have been granted because count 2 recites a spring projection at each end of a coil spring and Cleveland's apparatus has no spring projection. As such, count 2 does not define common interfering subject matter between the parties. 37 C.F.R. § 1.601(f).

A projection is a part which juts out from a structure, and it is considered that end coils 33 of spring 26 in Cleveland do not jut out, inwardly or outwardly, from the spring. We do not agree with Juliano that the end coils 33 jut out from the spring 26 because they are of reduced diameter.

In view of the above decision, this proceeding is being redeclared in an accompanying paper with count 1 substituted for count 2.

We are further of the opinion that Juliano claim 13 should not have been added to this proceeding as a corresponding claim. Juliano's claim 13 includes the term "said spring being a coil spring having a spring projection at each end thereof which extends radially inward relative to the main central portion of the spring", and count 1 and the corresponding claims recite "said spring being a coil spring having the end coil on each end thereof being of reduced diameter as compared to the main central portion of the spring". It was not established by evidence from the prior art that claim 13 defines the same patentable invention as the count. 37 CFR § 1.737(c)(2)(ii). Whereas Juliano did not establish by evidence or convincing argument that the invention of claim 13 is the same patentable invention as the count by showing that the invention of claim 13 is obvious over the invention of count 1 assuming the invention of count 1 is prior art with respect to the invention of claim 13 (37 CFR § 1.601(n)), claim 13 does not correspond to count 1.

The accompanying redeclaration will show that Juliano's claim 13 has been deleted as a corresponding claim.

Whereas Juliano's only remaining claims 10-12 are unpatentable to Juliano, our above decision is dispositive of this case and we need not discuss Cleveland's case for priority.

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Judgment

Judgment as to the subject matter of count 1, the only count, is hereby awarded to Orison Cleveland III, the junior party. On the present record, the party Cleveland is entitled to its patent with claims 1-7; the party Juliano is not entitled to a patent with claims 10-12.

STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

WILLIAM F. PATE III
Administrative Patent Judge

JOHN C. MARTIN
Administrative Patent Judge

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